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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,055	03/19/2004	Matthew R. Sivik	3246	7978

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THE LUBRIZOL CORPORATION
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EXAMINER

LANG, AMY T

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/805,055

Applicant(s)

SIVIK ET AL.

Examiner

Amy T. Lang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 9/28/05.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:
 - (i) page 8, line 2 of the specification includes the phrase "alcohol is may be linear," which is grammatically incorrect.
 - (ii) page 9, line 23 contains the phrase "w is tin," which should be replaced with "w is then."
 - (iii) page 17, line 27 contains the phrase " examples of suitable the optional solvents," where "the" should be removed from the sentence.Appropriate correction is required.

Claim Objections

2. Claim 9 is objected to because of the following informalities: Claim 9 repeats the phrase "of the" in line 3. Appropriate correction is required.

Use Claims

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 is a "use claim." According to the MPEP 2173.05(q) such claims raise an issue of indefiniteness under 112, second paragraph.

In particular, claim 12 provides for the use of imparting at least one improved property, but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

5. Additionally, 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Thus, claim 12 is also rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites the limitation where the range of vinyl aromatic monomer is from 0.7 to 1 mole equivalents compared to the amount of dicarboxylic acid anhydride. The

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applicant then claims the range of dicarboxylic acid anhydride to vinyl aromatic monomer from 0.7 to 1 mole equivalents. Such a recitation produces a contradiction that renders the scope of the claim indefinite. Thus, if the value of vinyl aromatic monomer is 0.8 mole equivalents to, say, 1 mole equivalents of dicarboxylic acid anhydride then that would give 1.25 mole equivalents of dicarboxylic acid anhydride relative to vinyl aromatic monomer, which is outside the scope of about 0.7 to 1 mole equivalents of dicarboxylic acid anhydride to vinyl aromatic monomer.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lange (US 6,258,761 B1) in view of Andrew (US 5,585,335) and Caruso (US 4,104,177).

Lange discloses a lubricating composition comprised of an esterified interpolymer derived from monomers of vinyl aromatic monomers and carboxylic acid derivatives (column 1, lines 4-7; column 8, lines 56-63). Since Lange defines an interpolymer as "a polymer derived from two or more different monomers" (column 8, lines 24-30), given that the instantly claimed polymer is also derived from two different monomers, it is evident that the interpolymer disclosed by Lange overlaps the instantly claimed polymer. The esterified polymers are disclosed with specific TAN values of 15 and 12.2 (Example A-1 and Example A-2, column 15)

The vinyl aromatic monomers disclosed by Lange include styrenes, substituted styrenes, and mixtures (column 10, lines 24-36). The carboxylic acid derivative is further disclosed as dicarboxylic acids or anhydrides including maleic anhydride, which clearly overlaps the instant claims (column 10, lines 38-55). The molar ratio of styrene to maleic anhydride is 1-3 to 2-1 (column 12, lines 65-67).

The composition disclosed by Lange is used as a viscosity and dispersant improving additive (column 1, lines 4-7). Therefore, this composition would improve thickening, increase longevity, and decrease wear, which clearly overlaps the instant claim 12.

A method is also disclosed to prepare the composition, which includes mixing the previously disclosed esterified interpolymer with a solvent (column 13, lines 4-20). The interpolymer is then esterified with alcohols having 8 to 22 carbon atoms or ones containing less than 7 carbon atoms and ones containing at least 7 carbon atoms (column 13, lines 54-58; column 14, lines 4-9). The alcohols are used to convert from

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80 to 90% of the carboxy groups in the carboxylic acid derivative to ester groups (column 14, lines 18-23). The interpolymer is then reacted with an amine with more than one functional group (column 17, lines 34-40; column 23, lines 2-15; column 30, lines 9-12). The final reactant is combined with lubricating oil and additives (column 34, lines 50-55, line 64 through column 35, line 5).

The final lubricating composition comprises the esterified polymer in amounts from 0.5 to 30 wt%, the lubricating oil being greater than 50 wt%, and the additives from 0.01 to 20 wt% (column 29, lines 38-48). Specific additives are disclosed including metal salts of carboxylic acids and compounds containing urea (column 35, lines 50-53; column 36, lines 61-66).

Lange does not disclose the lubricating composition as a grease composition.

Andrew discloses that metal salts of carboxylic acids are used as thickening agents in lubricating compositions (abstract). This is also reaffirmed by the instant specification which discloses that thickening agents as metal salts of carboxylic acids are known in the art (page 10, lines 26-27 of the instant spec.) Caruso discloses that compounds containing urea are also used as thickening agents (column 1, lines 10-12). Therefore, since Lange discloses both compounds in the lubricant, they intrinsically act as thickening agents to produce a grease composition.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy T. Lang whose telephone number is 571-272-9057. The examiner can normally be reached on M-F 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

9/20/06

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